

**TRANSMITTAL LETTER**  
(General - Patent Pending)

Docket No.  
98-109

In Re Application Of: WALKER et al.

Serial No.  
09/219,267

Filing Date  
December 23, 1998

Examiner  
James W. Myhre

Group Art Unit  
3622

Title: METHOD AND APPARATUS FOR FACILITATING ELECTRONIC COMMERCE THROUGH PROVIDING CROSS-BENEFITS DURING A TRANSACTION

**RECEIVED**

FEB 09 2004

**GROUP 3600**

TO THE COMMISSIONER FOR PATENTS:

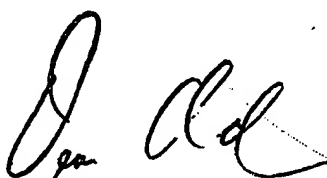
Transmitted herewith is:

Request for Reconsideration (Prematurity of Final Rejection - MPEP §706.07(c)) (4 pp.) (x2);  
Supplemental Information Disclosure Statement (5 pp.);  
PTO Form-1449 (1 pg.) and references cited therein (4); and  
Return Receipt Postcard.

in the above identified application.

- ☐ No additional fee is required.
- ☐ A check in the amount of \_\_\_\_\_ is attached.
- ☒ The Director is hereby authorized to charge and credit Deposit Account No. \_\_\_\_\_ as described below.
- ☒ Charge the amount of \$180.00
- ☒ Credit any overpayment.
- ☒ Charge any additional fee required.

50-0271



Signature

Dated: January 28, 2004

P. Alderucci  
Key for Applicants  
Registration No. 40,484  
1-7337/phone  
7300/fax

RR NO. 22927  
walkerdigital.com

I certify that this document and fee is being deposited on January 28, 2004 with the U.S. Postal Service as first class mail under 37 C.F.R. 1.8 and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.



Signature of Person Mailing Correspondence

Michael D. Brinton

Typed or Printed Name of Person Mailing Correspondence



## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:

WALKER et al.

Application No.: 09/219,267

Filed: December 23, 1998

For: METHOD AND APPARATUS FOR  
FACILITATING ELECTRONIC  
COMMERCE THROUGH  
PROVIDING CROSS-BENEFITS  
DURING A TRANSACTION

Customer No.: 22927

) Group Art Unit: 3622

)

) Examiner: James W. Myhre

)

)

) **REQUEST FOR RECONSIDERATION**) **(Prematurity of Final Rejection -**) **MPEP - §706.07(c))**

)

) Attorney Docket No.: 98-109

)

) Walker Digital, LLC

) (203) 461-7337/voice

) (203) 461-7300/fax

)

)

)

**RECEIVED****FEB 09 2004****GROUP 3600**

## CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with  
the United States Postal Service as first class mail in an envelope  
with sufficient postage and addressed to: Commissioner for  
Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: 01/28/04 By: Michael D. Brinton

Michael D. Brinton

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**REQUEST FOR RECONSIDERATION**  
**(PREMATURITY OF FINAL REJECTION - MPEP §706.07(c))**

**Action Requested**

Applicants request that the finality of the Office Action mailed January 9, 2004 (paper  
no. 31) be withdrawn and prosecution on the present application be reopened.

**Points to be Reviewed**

Whether the Office Action mailed January 9, 2004 was made final prematurely, given that a new ground of rejection of claims **5, 45 and 62** was entered in that Office Action.

**Summary of Facts Involved**

The Examiner in the Office Action mailed January 9, 2004 introduced a new ground of rejection of claims **5, 45 and 62**, but made that Office Action final.

This rejection was not necessitated by Applicants amendments - Applicants did not amend any claim after any Office Action, much less amend claims **5, 45 and 62**.

This rejection also was not necessitated by any information submitted by Applicants - the rejection was not based on information submitted in an IDS filed during the period set forth in 37 CFR 1.97(c).

**Full Statement of Facts Involved**

In the First Office Action (mailed May 17, 2001) and the Second Office Action (mailed February 14, 2002), all claims were rejected in light of either:

Logan,  
Logan and Saxe, or  
Logan and Weinblatt.

Applicants filed an Appeal Brief, and the Examiner reopened prosecution to enter a new ground of rejection in the Third Office Action. In the Third Office Action (mailed April 22, 2003), all claims were rejected in light of either:

Myhre,  
Myhre and Saxe, or  
Myhre and Weinblatt.

Applicants did not amend any claims after the Third Office Action (or after any other Office Action for that matter)

Then, in the Fourth Office Action (mailed January 9, 2004), claims **5, 45 and 62** were rejected in view of a new combination of:

Myhre and Logan.

This was a new rejection of claims **5, 45 and 62**. In fact, Myhre and Logan were never previously combined in any rejection of any claim.

Despite the new grounds of rejection, this Fourth Office Action was made final. No reasoning was provided for why this Office Action was made final.

#### **Arguments and Authorities**

According to MPEP 706.07(a) (8<sup>th</sup> Ed., rev. 1, Feb. 2003):

"second or any subsequent actions on the merits shall be final, **except** where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)."

(emphasis added)

The Fourth Office Action introduced a new ground of rejection (claims **5, 45 and 62** were rejected in light of a combination of Myhre and Logan). This new rejection was neither necessitated by applicant's amendment of the claims (Applicants did not amend the claims) nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) (neither Myhre nor Logan was submitted in any such IDS).

**Conclusion**

For the foregoing reasons it is submitted that all of the claims are now in condition for allowance and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remains any question regarding the present application or any of the cited references, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Dean Alderucci at telephone number 203-461-7337 or via electronic mail at Alderucci@WalkerDigital.com.

While no fees are believed to be due at this time, please charge any fees that may be required for this Request for Reconsideration to Deposit Account No. 50-0271. Furthermore, should an extension of time be required, please grant any extension of time which may be required to make this Amendment timely, and please charge any fee for such an extension to Deposit Account No. 50-0271.

Respectfully submitted,



Dean P. Alderucci  
Attorney for Applicants  
Registration No. 40,484  
Alderucci@walkerdigital.com  
Walker Digital, LLC  
(203) 461-7337 /voice  
(203) 461-7300 /fax

January 28, 2004  
Date